Attorney Docket No.: 2078-3-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Jin-Koo Rhee
Hyun-Sik Park
Dan An
Yeon-Sik Chae

Art Unit: 2811

Examiner: L. Thai

Serial No: 09/755,436

Filed: January 4, 2001

For: TRANSISTOR WITH π-GATE STRUCTURE AND METHOD FOR PRODUCING THE SAME

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
Assistant Commissioner for Patents
Washington D.C. 20231, on
January 31, 2002
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Amit Sheth
Name
Amit Sheth 01/31/02
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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated January 2, 2002, in connection with the above-identified application, please enter and consider the following remarks.

REMARKS

The applicants have studied the Election/Restriction Requirement dated January 2, 2002. Claims 1 and 2 are in the case. The Examiner has required restriction to one of the following two groups of the claimed invention:

Group I. Claim 1; and

Group II. Claim 2.

In response to the Examiner's election requirement, the applicants hereby traverse the requirement and respectfully request reconsideration. However, under 37 C.F.R. § 1.143, applicants hereby provisionally elect claim 1.

The Election/Restriction Requirement under 35 U.S.C. § 121 was made due to Examiner's belief that the inventions in Groups I and II are distinct. Under MPEP § 806.05(f),

inventions are distinct if a product as claimed can be made by another and materially different process than the claimed process. The Examiner noted that the invention of Group I could be made by processes different from those of Group II and, consequently, is distinct from the invention of Group II. The Examiner also noted that the inventions of Groups I and II acquired separate status as shown by their different classification.

In Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc., the Federal Circuit ruled that separate apparatus and method claims in the same application do not direct to separate inventions and the presence of such claims is not grounds for restriction. Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc., 98 F.3d 1563, 1577-78, 40 USPQ2d 1481, 1492 (Fed. Cir. 1996). The court further stated that the "PTO correctly recognizes that these [separate apparatus and method claims] may be just two different ways of claiming the same invention." Id. Finally, the Federal Circuit stated that grounds for restriction cannot only be based on separate classification. Id. at 1576-77.

In applying the Federal Circuit's holdings in Applied Materials to the case at hand, the inventions of Groups I and II should be considered as a single general inventive concept and thus should not be subject to a restriction requirement. The invention of Group II (the process for making the product) is adequately specific to create the invention of Group I, in particular with regard to the π – gate structure. The facts that the invention as claimed consists of separate apparatus and method claims and that, according to the Examiner, separate classification is consequently required do not propose a restriction requirement under Applied Materials.

Applicants reserve the right to file a divisional application directed to non-elected claim.

In view of the foregoing, it is respectfully submitted that the application and the claims, as amended, are in condition for reconsideration on merits. Examination of the application, as amended, is requested. The Examiner is invited to call the undersigned attorney at (213) 250-7780 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,
LEE & HONG

Date: January 31, 2002

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